

REMARKS

This application has been reviewed in light of the Office Action dated December 24, 2007. Claims 1-23 are presented for examination, of which Claims 1, 12, and 23 are in independent form. Claims 1, 12, and 23 have been amended to define more clearly what Applicant regards as his invention. Favorable reconsideration is requested.

On November 9, 2007, one of Applicant's attorneys conducted a telephonic interview with the Examiner to discuss the features of Claim 1, and in particular to present arguments as to why the cited portions of U.S. Patent 7,089,286 (*Malik*) and U.S. Patent 6,825,955 (*Shibata*) are not believed to teach or suggest the features of Claim 1. Applicant notes that the Examiner's Interview Summary states that an understanding was reached between the Examiner and Applicant's attorney, and reads that as reflecting that the Examiner and Applicant's attorney understood each other's readings of the prior art and of the claim. Applicant agrees with the notation in the Summary that agreement was not reached (as to allowability of the claim).

Claims 1, 2, 4-6, 9-13, 15-17, and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,089,286 (*Malik*) and U.S. Patent 6,825,955 (*Shibata*); Claims 3, 8, 14, and 19 were rejected as being unpatentable over *Malik* and *Shibata* in view of U.S. Patent 6,868,183 (*Kodaira*); and Claims 7 and 18 were rejected as being unpatentable over *Malik* and *Shibata* in view of U.S. Patent 6,157,389 (*Knowlton*). Applicant submits that independent Claims 1, 12, and 23, together with the claims dependent therefrom, are patentably distinct from the cited prior art for at least the following reasons.

One aspect of the present invention, set forth in Claim 1, is a communication apparatus comprising connecting means for connecting the communication apparatus to a communication network containing an electronic mail exchange device. Input means are provided for inputting image data representing an image, and transmitting means are provided for transmitting an electronic mail, to which the image data inputted by said input means is attached, via said connecting means. Receiving means are provided for receiving an electronic mail as notification of an error, via said connecting means, and analyzing means analyze such the electronic mail. Converting means are provided for converting the size of the image data, inputted by said input means, into a smaller size according to an analysis result obtained by the analyzing means, and control means in such a case automatically carry out a controlling operation to retransmit the electronic mail, to which the image data with the size thereof converted by the converting means is attached, by said transmitting means, in response to the receiving means receiving the electronic mail for notifying the error which indicates that the size of the electronic mail transmitted by said transmitting means is too large. Output means are also provided for outputting a report including at least a transmitting date, a destination, original information for specifying a parameter of the image data input by said input means, and retransmission information for specifying a parameter of the image data which has been converted by the converting means, in a case where a retransmitting of the electronic mail by the transmitting means has been carried out.

Among other notable features of Claim 1 are the output means for outputting a report including at least a transmitting date, a destination, original information for specifying a

parameter of the image data input by said input means, and retransmission information for specifying a parameter of the image data which has been converted by the converting means, in a case where a retransmitting of the electronic mail by the transmitting means has been carried out. An example of the original information includes the 'reading resolution' shown in Figs. 36 and 37, and an example of the retransmission information includes the 'transmission resolution' shown in Figs. 36 and 37.¹ By virtue of this feature of Claim 1, even if the electronic mail is unsuccessfully retransmitted with the resolution changed, it is possible to know the details of the retransmission. More specifically, a user can easily grasp from the original information, the parameter of the originally input image data which could not be transmitted. The user can also easily grasp from the retransmission information, the parameter of the converted image data which could be retransmitted.

Malik relates to a system for compressing e-mail attachments for transmission, in which a table stores a compressibility factor for each of various types of files, indicating by what percentage a file of a given type can be compressed.

The Office Action concedes that *Malik* does not disclose expressly outputting a report after transmitting an electronic mail.

Shibata, as understood by Applicant, relates to a device, such as a facsimile machine, that is capable of transmitting an image by both electronic mail and facsimile and is

¹ It is of course to be understood that the claim scope is not limited by the details of this or any other particular embodiment that may be referred to.

also capable of notifying the receiver facsimile device of an incoming electronic mail using a facsimile protocol.

Applicant submits that *Shibata* also fails to teach or suggest a communication apparatus that includes output means for outputting a report including at least a transmitting date, a destination, original information for specifying a parameter of the image data input by said input means, and retransmission information for specifying a parameter of the image data which has been converted by the converting means, in a case where a retransmitting of the electronic mail by the transmitting means has been carried out.

Accordingly, Applicant submits that Claim 1 is patentable over *Malik* and *Shibata*, considered individually or in any permissible combination (if there is any). Therefore, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a).

Independent Claims 12 and 23 are method and computer medium claims, respectively, corresponding to apparatus Claim 1, and are believed to be patentable for at least the same reasons as discussed above in connection with Claim 1.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or the other of Claims 1 and 12, and are therefore believed patentable for the same reasons. Since each

dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and an early issuance of a Notice of Allowance.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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